

APPLICANT(S): ANDERSON, Robert S. et al.  
SERIAL NO.: 10/767,459  
FILED: January 30, 2004  
Page 4

#### **AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawings includes changes to Figs. 1A, 1B, 4A, 4B and 6. This sheet, which includes Figs. 1A, 1B, 4A, 4B and 6, replaces the original sheet including Figs. 1A, 1B, 4A, 4B and 6.

Attachment: Replacement Sheets

APPLICANT(S): ANDERSON, Robert S. et al.  
SERIAL NO.: 10/767,459  
FILED: January 30, 2004  
Page 7

### **REMARKS**

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### **Status of Claims**

Claims 1-85 are pending in the application.

Claims 1-68 have been rejected.

Claims 1-69 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

Claims 69-85 have been newly added in this submission. No new matter has been added.

### **Personal Interview**

Applicants are grateful to the Examiner for conducting a personal interview with Applicants' representatives, Guy Yonay and Zeev Pearl, which Applicants found to be helpful for this submission.

### **Remarks to the Drawings**

In response to the Examiner's objection to the drawings on page 2 of the Office Action, Figs. 1A, 1B, 4A, 4B and 6 are being replaced to conform with drawing regulations, for example, to provide reproducible shading as required by 37 CFR 1.84, or for improved

APPLICANT(S): ANDERSON, Robert S. et al.  
SERIAL NO.: 10/767,459  
FILED: January 30, 2004  
Page 8

clarity. The entire drawing sheet containing each corrected drawing is enclosed for review by the Examiner.

#### **Remarks to the Specification**

In accordance with the observations and suggestions of the Examiner on page 2 of the Office Action, the specification has been amended to correct minor grammatical errors, minor informalities, and to place the same in better form. Specifically, in paragraph 007 "They" has been replaced with "The", in paragraph 0061, "1" has been replaced with "2", and in paragraph 0070, the acronym ILP has been restated. The amendments to the specification are editorial in nature and do not introduce new matter.

#### **Double Patenting Rejections**

In the Office Action, the Examiner objected to claims 10 and 12 as being substantial duplicates of each other. Accordingly, claim 12 has been cancelled without prejudice.

In the Office Action, the Examiner objected to claims 37 and 41 as being substantial duplicates of each other. Accordingly, claim 41 has been cancelled without prejudice.

#### **CLAIM REJECTIONS**

##### **35 U.S.C. § 112 Rejections**

In the Office Action, the Examiner rejected claims 10, 12-15, 42-45 and 58-61 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and particularly based on certain informalities. These claims have been canceled.

Accordingly, Applicants request withdrawal of the rejection.

APPLICANT(S): ANDERSON, Robert S. et al.  
SERIAL NO.: 10/767,459  
FILED: January 30, 2004  
Page 9

### **35 U.S.C. § 102 Rejections**

In the Office Action, the Examiner rejected claims 1-3, 6-15, 16-18, 20-25, 27, 29, 30, 46, 47, 49 and 53-55 under 35 U.S.C. § 102(e), as being anticipated by Altshuler et al. (US Patent No. 6,605,080).

As discussed during the interview, Altshuler discloses treatment using light energy. Accordingly, Altshuler does not teach or disclose “at least two electrodes having contact surfaces adapted to contact tissue collected therebetween” or “an electrical energy source connected to said electrodes” as recited in claims 69 to 74. Moreover, Altshuler does not teach or disclose “collecting a portion of tissue between at least two contact surfaces of respective at least two electrodes, such that an outer surface of said tissue is in contact with said surfaces of said electrodes” or “applying electrical energy to said portion of tissue collected between said electrodes” as recited in claims 75 to 85.

Nor would it have been obvious to modify Altshuler to include the above elements of apparatus claims 69 to 74, or method claims 75 to 85, insofar as introducing such elements into the disclosure of Altshuler would render it inoperable for its intended purpose (i.e., treatment via emission of light).

### **35 U.S.C. § 103 Rejections**

In the Office Action, the Examiner rejected claims 33, 34, 35, 37-45, 50-52, 56 and 57 under 35 U.S.C. § 103(a), as being unpatentable over Altshuler et al. (US Patent No. 6,605,080) in view of Knowlton (US Patent No. 5,948,011).

Knowlton describes applying RF energy through a porous medium by a pad placed on the skin. Knowlton does not disclose “a device having a cavity therein” or “at least two electrodes having contact surfaces adapted to contact tissue collected therebetween” as recited in claims 69 to 74, nor “collecting a portion of tissue between at least two contact surfaces of respective at least two electrodes, such that an outer surface of said tissue is in contact with said surfaces of said electrodes” as recited in claims 75 to 85.

It would also not have been obvious to combine the teachings of Knowlton with Altshuler. The Examiner has not supplied sufficient motivation for one of ordinary skill in

APPLICANT(S): ANDERSON, Robert S. et al.  
SERIAL NO.: 10/767,459  
FILED: January 30, 2004  
Page 10

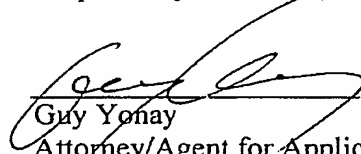
the art to combine the teachings of the references, nor would an operable device result from the combination. In any event, even if the references were combined, the recited elements of apparatus claims 69 to 74 and the recited steps of method claims 75 to 85 would not result.

It is respectfully submitted that the remaining references cited or of record are not applicable to the newly added claims, and therefore that independent claims 69 and 75, and dependent claims 70-74 and 76-85, which depend therefrom, are allowable. In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

  
Guy Yonay  
Attorney/Agent for Applicants  
Registration No. 52,388

Dated: July 13, 2006

**Pearl Cohen Zedek Latzer, LLP**  
1500 Broadway, 12th Floor  
New York, New York 10036  
Tel: (646) 878-0800  
Fax: (646) 878-0801

# APPENDIX